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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,244	04/03/2001	Alain Bethune	05725.0875-00	8888

22852 7590 01/03/2006

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EXAMINER
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SPERTY, ARDEN B

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/824,244

Applicant(s)

BETHUNE ET AL.

Examiner

Arden B. Sperty

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 25 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**NON-FINAL OFFICE ACTION**

1. Applicant's Reply Brief, dated 3/11/05, has been considered, and Applicant's points are well-taken. Prosecution is therefore reopened, and Applicant's petition, 11/23/04, to have the After Final amendment of 9/02/04 entered, is granted. The After Final amendment consists of amendments to the specification and drawings, and arguments. The claim listing, as it appears in Applicant's response dated 3/23/04, is examined; amendments to the claims were not submitted in the After Final amendment.

The 35 USC 112, second paragraph, rejections of the previous office action (Final Action, 6/02/04) are vacated.

The 35 USC 102(b) rejections in view of Burns are vacated because the differently-colored metals are not the outermost layers; a layer 5 overlays some of the metallic coating(s).

The 35 USC 103(a) rejection in view of US 6546751 to Jaeger is withdrawn because differently-colored metals are not visible on the surface of the support.

The 35 USC 103(a) rejection in view of DE 3030403 to Rodi is withdrawn because although two differently-colored metals are visible, the reference is silent with respect to a support analogous to Applicant's claimed support.

The 35 USC 103(a) rejection in view of DE 3704403 to Mitsubishi remains, as stated below.

The claims are also rejected herein, in view of art uncovered during an updated search.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language does not recite positive limitations to further limit the subject matter of claim 1. Claim 15 is indefinite because the implied structure is not clear, as a result of the claim's dependency on indefinite claim 9.

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 5-10, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over US 2731333 to Ko et al.

The reference teaches one or more superimposed coatings of different colored metal(s), upon a contrastingly colored base of synthetic resin or the like (col. 1, lines 55-57). Specifically mentioned is a three-color embodiment where two superimposed coatings of different metals are etched (col. 4, lines 65+) such that an aesthetic design is created wherein both metal colors are visible, as well as the resin plate (col. 5, lines 30-33). The regions where both metal layers are intact is analogous to Applicant's claimed first metallic coating, in this case having  $n=2$ . The regions having only the outermost metal layer removed, such that the innermost metal layer is visible, are analogous to the claimed second metallic coating, in this case having  $n=1$ . Although the reference teaches finishing the laminate with a clear coating (col. 5, lines 34-36), the uncoated intermediate anticipates the claimed invention wherein the outer layer of the first metallic coating and the outer layer of the second metallic coating form the outer surface of the support. In the alternative, it would have been obvious to one of ordinary skill in the art to omit the clear coat, motivated by a desire to reduce manufacturing costs.

Regarding claim 2, the metal coatings may be applied by any of a variety of methods known in the art (col. 3, lines 41-46) including electro-deposition. The coatings may also be made of any of a number of different metals (col. 3, lines 38-40), thus anticipating claims 5-7.

Claims 8-10 do not patentably distinguish over the prior art. The claims imply function, not structure. Regarding claims 8 and 10, "container" and "stopper" do not imply structure to differentiate over the prior art. The terms refer to function only, and

the structures of the prior art can meet such functional requirements. Regarding claim 9, no additional structure is implied beyond that of claim 1.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2731333 to Ko et al, as applied to claim 1 above.

Regarding claims 11 and 12, "container" and "stopper" do not imply structure to differentiate over the prior art; the terms refer to function only. The limitations of the claim that are given weight are the specific structural requirements, namely the transverse wall and a lateral skirt. Selection of an object and surface on which to perform the decorative surface finishes taught by the Ko reference would have been a matter of personal preference, and therefore obvious to one of ordinary skill in the art. Although the prior art is silent with respect to Applicant's design choice, the design of the object is not seen to patentably distinguish over the prior art because it is merely a matter of personal preference.

Regarding claim 13, the Ko reference does not limit the number of metallic layers, and leaves the personal choice of the number and color of the metal layers up to

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the user. The reference teaches "one or more superimposed coatings of different-colored metal" (col. 1, lines 55-56), which is seen to render obvious the claimed  $n=3$ .

8. Claims 1, 5-10, 13, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3704403 to Mitsubishi.

The Mitsubishi reference teaches metal plates, bonded together to form a layer-structured plate. At least one decorative groove with outwardly increasing width is formed on at least one side of the plate, and the plate is rolled to provide a striped pattern. The metal layers are molded in plate form.

Regarding claims 5-7, metals appropriate for use in the invention of Mitsubishi are those used in jewelry making, as mentioned in the abstract. The claimed metals are common in jewelry making, thus the claimed metals would have been obvious to one of ordinary skill in the art. An English translation of the reference is pending, and may specifically disclose the claimed metals.

Claims 8-10 do not patentably distinguish over the prior art. The claims imply function, not structure. Regarding claims 8 and 10, "container" and "stopper" do not imply structure to differentiate over the prior art. The terms refer to function only, and the structures of the prior art can meet such functional requirements. Regarding claim 9, no additional structure is implied beyond that of claim 1.

***Allowable Subject Matter***

9. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the

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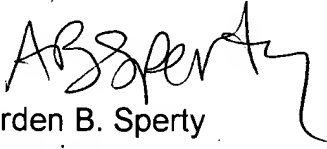
base claim and any intervening claims. Although the structure of the container is not specified, the prior art is not seen to teach or suggest the system, including a cosmetic product contained within a container.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Arden B. Sperty  
Examiner  
Art Unit 1771

December 6, 2005

  
TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700